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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,730	06/12/2001	Kenji Nagoya	B422-161	4879

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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/879,730	<b>Applicant(s)</b> NAGOYA ET AL.	
	<b>Examiner</b> Yogesh C. Garg	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-18,20,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-18,20,21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/3/2006 has been entered.

### ***Response to Amendment***

2. Applicant's amendment received on 1/3/2006 is acknowledged and entered. The applicant has currently amended claims 1,3,7,12,14,18 and 23. Currently claims 1-7, 9-10, 12-18, 20-21 and 23 are pending for examination.

### ***Response to Arguments***

3.1. Since the applicant has currently amended claims 12 and 23 , the rejection of claims 12-18, 20-21 and 23 under 35 U.S.C. §101 [submitted in the previous office action] is withdrawn.

3.2. Since the applicant has currently amended claims 1, 12 and 23 , the rejection of claims 1-7, 9-10, 12-18, 20-21 and 23 under 35 U.S.C. §112, first paragraph and Objection to Specification [submitted in the previous office action] are withdrawn. However, another 35 U.S.C. §112, first paragraph rejection of claims 1-7, 9-10, 12-18,

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20-21 and 23 and Objection to Specification are given below due to situation created by the current amendments.

3.3. Applicant's arguments (see Remarks, pages 8-10) with respect to prior art rejection of claims 1-7, 9-10, 12-18, 20-21 and 23 have been considered but are moot in view of the new ground(s) of rejection necessitated due to current amendments.

3.4. This is a non-final rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7, 9-10, 12-18, 20-21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the currently amended claims 1, 12 and 23 the applicant has included the limitation, " that the apparatus includes a discriminator unit/code configured to discriminate number of pages which are printed in a sheet of paper" , which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. user.

***Objection to Specification***

5. The amendment filed on 1/3/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "that the apparatus includes a discriminator unit/code configured to discriminate number of pages which are printed in a sheet of paper" in claims 1, 12 and 23.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

7 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 12-18, 20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi (US Patent 6,385,675).

7.1. Regarding claim 1, Yamaguchi discloses an information processing apparatus capable of printing data by using another apparatus connected to a network (see at least FIGs.1-2 and 4 and col.2, line 15-col.4, line 67. The image processor 101 is the information process apparatus using another apparatus100 the copying machine to print data via a network.), comprising:

discriminating unit configured to discriminate a number of pages which are printed o a sheet of paper, during a predetermined process of making a print data recognizable by the other apparatus in accordance with a print instruction by a user and calculating unit configured to calculate a print charge based on a discrimination result discriminated by said discrimination unit before the print data is sent to the network (see at least Figs 1-2, 4, col.2, line 49-col.3, line 8 and col.3, line 55-col.4, line 67 where 101G and 101H in Fig.2 correspond to claimed discriminator and calculator units.

Regarding claims 2-3, Yamaguchi discloses an information processing apparatus according to claim 1, wherein calculation by said calculating unit is performed by a control program for controlling the other apparatus (see at least col.2, line 49-col.3,

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line 8. The accounting unit 101H processes the cost of the print job using an accounting program in order to control the print function to be done on the printing/copying unit 100) and the discrimination by said discrimination unit is performed by a control program for controlling the other apparatus, and calculation by said calculating unit is performed by a charge application which is activated by a process different from the control program (see at least col.2, line 49-col.3, line 8 and col.3, line 55-col.4, line 67 and Fig.4. Discrimination functions are performed by the controller of the image process whereas calculating is done by a separate accounting program as indicated above).

Regarding claims 4-7, Yamaguchi discloses/suggest that an information processing apparatus according to claim 1, wherein whether calculation by said calculating unit is performed and whether the print data is sent to the network after the calculation by said calculating unit, is settable beforehand/ wherein if the output charge calculated by said calculating unit exceeds a predetermined value, the output data is not sent to the network/ further comprising notifying unit for notifying a user of the output charge calculated by said calculating unit/ further comprising a unit responsive to an operation by the user for terminating an output process without sending the output data to the network or for changing of pages which are printed in a sheet of paper (see at least col.2, line 49-col.3, line 8 and col.3, line 55-col.4, line 67 and Fig.4. The controller 101I of the image processor 101 calculates the charge beforehand and notifies to the user so that any changes can

be carried before sending the print data to the printer 100 and the changes can include any modification or termination of the order after knowing the charges).

Regarding claim 9, Yamaguchi discloses that the information processing apparatus according to claim 1, calculating unit calculates the output charge in accordance with charge information stored in the information processing apparatus (see at least col.3, lines 9-21).

7.2. Regarding claims 12-18, 20, and 23 there limitations are closely parallel to the limitations of claims 1-7 and 9 and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Yamaguchi and further in view of an Official Notice.

8.1. Regarding claim 10, Yamaguchi discloses the information processing apparatus and a program for calculating the print charges of the customized print data as per the instructions of an user as analyzed above for claim 9. Yamaguchi does not explicitly



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state that the charge information is updated. However, the examiner takes an Official Notice of the fact and benefits of updating any stored information for the obvious reason of being able to know the prevailing rates for any job/services and submit the realistic price quote/information to the buyer. In view of the Official Notice it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Yamaguchi to incorporate the feature of updating the information related to vendors, their bids, etc which is related to charge information for the print jobs because it would enable the system to calculate the price bid for print jobs requested by the user based on latest vendor prices rather than obsolete and old stored prices and avoid the waste of time and money which will result by considering obsolete vendor data/prices.

8.2. Regarding claim 21 its limitations are closely parallel to the limitations of claim 10 and is therefore analyzed and rejected on the same basis.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6865620 to Homma (see at least Abstract), US PG-Pub 20020073035 A1 to Saito (see at least Abstract), US PG-PUB 20040174561 A1 to Fukunga et al. (see at least paragraphs Abstract, paragraphs 0145, 0178, 0240 and 0325), and US PG-Pub 20020051177 A1 to Nomoto(see at least Abstract, paragraphs 0067, 0074, 0087-0088),

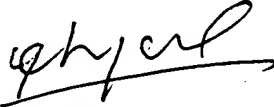
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suggest or disclose computerized method and system using computer, another apparatus to print/copy and calculating unit to print the ordered print jobs from users and calculate the charges.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
3/15/2006